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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/387,810	09/01/1999	SETH R. GOLDSTEIN	15280-312100	3041

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EXAMINER

HANDY, DWAYNE K

ART UNIT	PAPER NUMBER
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1743

9

DATE MAILED: 03/13/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/387,810

Applicant(s)

Goldstein et al.

Examiner

Dwayne K. Handy

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-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Dec 26, 2001
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 35-41 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 35-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirements.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 2
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

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DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

2. Claims 35 and 37-41 are rejected under 35 U.S.C. 102(e) as being anticipated by Liotta et al. (U.S. Pat. No. 5,843,644). Liotta et al. teaches a method of direct extraction of cellular material and an apparatus for performing the method. The extraction is performed using an apparatus which includes a contact probe (element #5) with an extraction reagent/coating (6) that contacts cellular material on microscope slides. The contact probe is then lifted from the slide with the cellular material attached to the end of the probe. The probe may then be placed into a solution which dissolves the tissue material which is then released from the extraction coating (Figures 2A-2C). The contact probe is shown best in Figures 2A-2C and is described in column 4, lines 21-61. Liotta teaches the use of glass for the probe in column 4, lines 55-60. This would meet the limitation of transparency (cl. 40).

3. Claims 35, 38, and 40 are rejected under 35 U.S.C. 102(e) as being anticipated by Adams et al. (U.S. Pat. No. 6,060,288). Adams et al. disclose methods and apparatus for performing nucleic acid hybridization and amplification reactions on a support. The synthesized nucleic acids are then detected and analyzed. In disclosing their system, Adams et al. describe the use of an optical fiber as the amplification support and/or a part of the product detection system (col. 16, lines 1-12). Adams et al. further describe the fiber element in column 16, lines 13-40 (also Figures 7A-7E. The “surface of the fiber may also be modified to have a convex or concave curvature...” and that the surface may be modified by an “...organosilane coating of glass and silica surfaces, graft polymerization...”. The reference describes attaching nucleotides to the end of the probe in column 16, lines 25-40.

Inventorship

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

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Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. Claim 36 is rejected under 35 U.S.C. 103(a) as being unpatentable over Adams et al. Adams et al., as described above in paragraph 3 above, teaches every element of claim 36 except for the convex surface of the rod shaped as a sphere. Adams, in column 22, lines 13-36, describes embodiments in which the surface may have additional layers attached and may be shaped (line 23). While Adams does not specifically recite a spherical shape, it would have been obvious to one of ordinary skill in the art to use a surface shape that is spherical. Adams uses

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optical fibers as the support and optical fibers often contain a spherical end. This would alleviate the need to shape the surface of the fiber before adding the surface modifications.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Tamaka discloses a device and method for creating a replica film of a tissue specimen. Robinson et al. recites a slide which has an adhesive portion attached to it for the purpose of collecting cells on the slide. Obremski et al. shows a system with multiple coated waveguides for analyzing target analytes. Deem et al. teaches an apparatus and methods for selectively stenting a portion of a vessel wall using selectively adhesive materials. Erb et al. discloses an apparatus for measuring the binding between a protein and a nucleotide.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dwayne K. Handy whose telephone number is (703)-305-0211. The examiner can normally be reached on Monday-Friday from 8:00 to 4:30.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden, can be reached on (703)-308-4037. The fax phone number for the organization where this application or proceeding is assigned is (703)-772-9310.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)-308-0661.


Jill Warden
Supervisory Patent Examiner
Technology Center 1700

dkh

March 11, 2002